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Date: June 1, 2004

To: Examiner Delia Ramirez
US Patent and Trademark Office
Fax: 703-872-9306

Subject: USSN: 09/750,986
Our Ref.: Eisenfuhr 9998.2-HCL/ 102150-13

From: Howard C. Lee

Comments: Filing of: response to Office Action dated 4 May 2004, including Response to Restriction Requirement (3 pgs.); copy of election of species requirement from SN: 08/976,063 (4 pgs.); Preliminary Amendment (4 pgs.)

If you have any questions or need further information, please contact us.

You should receive 12 pages including this cover sheet.

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Eisenfuhr 9998.2-HCL
102150-13
HA 3790-04US UST/ame

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : STEINBUCHER et al.
SERIAL NO. : 09/750,986
FILED : 28 December 2000
FOR : SYNTHETIC ENZYMES FOR THE PRODUCTION OF CONIFERYL
ALCOHOL, CONIFERYLALDEHYDE, FERULIC ACID, VANILLIN AND
VANILLIC ACID AND THEIR USE
ART UNIT : 1652
EXAMINER : Delia Ramirez

1 June 2004

Hon. Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22312-1450

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RESPONSE TO RESTRICTION REQUIREMENT

SIR:

In response to the restriction requirement dated 4 May 2004, Applicants hereby elect with traverse to prosecute the invention of Group IV, claims 1 and 2 (ferulic acid deacylase).

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of this response to the restriction requirement requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Election

The applicants elect, with traverse, the invention represented by Group IV (claims 1 and 2) which is directed in part to ferulic acid deacylase.

Traversal of Election

Before providing a more detailed explanation for the traversal, the applicants wish to express their confusion as to the organization of the restriction requirement. If accepting the examiner's position that multiple inventions are present in the application, the claims should have been subject to an election of species as was done in the parent application (SN: 08/876,063) by Examiner Tung - see copy of election of species portion of Paper No. 9 from SN: 08/976,063; see also MPEP 808.01(a) and Form Paragraph 08-01. Not only was this the proper action to be taken if accepting that multiple inventions are present, but Examiner Tung's action requires far less explanation than the seven page action which was prepared by the present Examiner.

As stated in MPEP 706.04, "Full faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general, an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner, or make a new search in the mere hope of finding something. >Amgen, Inc. v. Hoechst Marion Roussel, Inc., 126 F. Supp. 2d 69, 139, 57 USPQ2d 1449, 1499-50 (D. Mass. 2001)."

Regardless of whether an election of species or restriction requirement is maintained, the applicants traverse the Examiner's action that the applicants' invention is limited to that of claims 1 and 2 as at the very least the portion of the claims directed toward the making of or use of ferulic acid deacylase should also be examined on the merits as was done for eugenol hydroxylase in parent application SN: 08/976,063.

In order to be fully compliant with the traversal requirements for the restriction requirement of record, it is noted that "The particular reasons relied upon by the examiner for holding that the invention as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate." (see MPEP 816)

Additionally, the restriction requirement must indicate why the inclusion of multiple invention represents a burden to the office (see MPEP 803 - "If the search and examination of an entire application can be made without serious burden, *the examiner must examine it on the merits*, even though it includes claims to independent or distinct inventions."). Given the nature of the prior application, it is unclear why the present application would represent an undue burden for claims directed toward ferulic acid deacylase, method of making and method using thereof.

Preliminary Amendment Has Been Concurrently Filed

The Examiner's attention directed to the fact that the applicants have filed a preliminary amendment to amend claims 7 and 8 ("Use" claims) so that they are in compliance with U.S. practice. If the amendment becomes separated from this paper, please telephone the undersigned for a duplicate copy.

Request for Future Telephone Notification of Restriction/Election of Species Requirement

Although not required by statute, the PTO encourages the use of telephone restriction practice (see MPEP 812.01) which is consistent with PTO compact prosecution and customer service initiatives. The invention was not overly complex in terms of preparing the election of species nor had the applicant indicated any previous history that an election would not be made over the telephone (in the parent application, the election was made by telephone - see copy of election of species portion of Paper No. 9 from SN: 08/976,063). In addition, this application was filed on 28 December 2000 and appears to already be eligible for patent term extension.

If future applications are filed for this invention, it is requested that the Examiner telephone the applicants' representative for a telephone election in order to expedite prosecution.

Closing

Early and favorable action is earnestly solicited.

Respectfully submitted,

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Attachment: Copy of election of species requirement from SN: 08/976,063 (Paper No. 9) - 4 pages

CERTIFICATE OF FACSIMILE TRANSMISSION
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I hereby certify that the foregoing Response to Restriction Requirement (7 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 1 June 2004

By *Agata Glinska*
Agata Glinska